

C. APPLICANT'S COMMENTS

Claims 1, 5-7, 9, 14, 15, 19 and 20 are pending in this Application, with Claims 1 and 14 being amended and Claims 2 – 4, 8, 10 – 13 and 16 – 18 being cancelled. Applicant has amended the drawings to include an indication of the structure identifiable as a pad member 34 on Figures 5 through 10 in accordance with the Official Draftsperson's suggestion. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Cancellation of Claims 2 – 4, 8, 10 – 13 and 16 – 18 and reconsideration of Claims 1, 5-7, 9, 14, 15, 19 and 20 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraph 1 - 2 of the Official Action

The Applicant respectfully requests that the Examiner refer to the paragraphs below under which each statutory argument is addressed and argued in turn. The pertinent legal background for 35 U.S.C. §102(b) is set forth under the section addressing Paragraph 4 of the Official Action. The pertinent legal background under 35 U.S.C. 103(a) and application thereof is set forth under the section addressing Paragraph 6 of the Official Action.

Paragraph 3 of the Official Action

The Applicant respectfully requests that the Examiner accept the enclosed amended drawings (Figures 1 through 10). The figures now reflect the numbering of the pad member 34 that was previously unmarked. The Applicant has included a set of marked up drawings showing the changes made and a set of clean drawings.

Paragraph 4 of the Official Action

The Official Action rejected as-filed Claims 1-18 under 35 U.S.C. §102(b) as being anticipated by Kilby. The Applicant respectfully disagrees with this rejection particularly in view of the amendments made to the claims.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. In addition, the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public. *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Independent Claim 1 (as amended) of the present invention claims:

1. (Currently Amended) An adjustable firearm support system, comprising:
 - a base;
 - a plurality of support members adjustably attached to said base;
 - a support unit pivotally attached to said base about a pivot axis, wherein said support unit is capable of supporting a firearm;
 - a pivot axle attached to said support unit; and
 - a pivot adjuster attached to said base, wherein said pivot adjuster pivotally swivels said support unit about said pivot axle.

Looking at Claim 1 of the present invention (as amended), the Applicant respectfully submits that Kilby does not include a support unit that is capable of swiveling from side to side about the base when necessary. Kilby teaches a height adjuster rotatably held within the base, but there is no lateral adjustment means available in Kilby.

Additionally, there is no pivot adjuster found in Kilby. Once again, Kilby only has an adjuster for vertically positioning the support unit. The present invention's pivot adjuster is further specialized because of its ability to move laterally in incremental distances; such precision is necessary when sighting in the scope of a gun. This is accomplished by the handle (40) allowing minute turns whereby the support unit is repositioned.

Claims 5 – 7 and 9 of the present invention include the following features:

5. (Original) The adjustable firearm support system of Claim 1, wherein said support members allow for vertical adjustment of said base.
6. (Original) The adjustable firearm support system of Claim 5, wherein said support members are threadably connected to said base in a vertical manner.
7. (Original) The adjustable firearm support system of Claim 6, wherein said support members each include a locking collar for locking a desired vertical position with respect to said base.
9. (Original) The adjustable firearm support system of Claim 6, wherein said support members each include a handle for allowing rotation of said legs.

The Applicant concedes that Kilby does allow for vertical support where each support is threadably connected to the base in a vertical manner. However, the

Applicant submits that the remaining Claims 7 and 9 that are dependent upon Claim 6 are not inherently or expressly present in Kilby.

Kilby does have a form of a locking collar denoted as wing nuts in the Kilby Specification. However, this wing nut is positioned between the underlying surface and the base unit in Kilby. In order to raise or lower any of the corners of Kilby, the user is required to either reach under the base unit or lift up the entire unit to adjust the support members away from or towards the underlying surface. The wing nuts position underneath the base renders them far less accessible than the collars present above the base unit in the present invention.

Additionally, Kilby does not have the handles (numbered 30 in the present invention) attached to each support member. This produces the same problems in Kilby as noted in the prior paragraph. The handles of the present invention provide simple and efficient raising or lowering of any corner of the base unit. Kilby requires that the user reach underneath the unit, possibly adjust the wing nut, adjust the height of a corner without using a handle (thereby likely requiring the user to try to grasp the threads), refasten the wing nut, and reposition the base unit. This provides an impractical solution when only trying to adjust a minute amount on one side to level out the firearm's resting surface.

Claims 14 and 15 state as follows:

14. (Currently Amended) The adjustable firearm support system of Claim 143, wherein said pivot adjuster includes a pivot pin extending upwardly that is received by a support slot within said support unit.

15. (Original) The adjustable firearm support system of Claim 14, wherein said pivot adjuster is comprised of a threaded shaft with a threaded collar threadably positioned upon said threaded shaft and wherein said pivot pin is attached to said threaded collar.

Claims 14 and 15 use language further distinguishing the pivot adjuster from the structure and function of Kilby. These features include the support slot receiving the pivot pin and the threaded shaft with a threaded collar. The threaded shaft and collar are important because of the necessity of minute movements to reposition the firearm support. This is necessary because often a firearm is being sighted in at 300 to 400 yards and the slightest miscalculation or overcompensation when sighting in a firearm could result in a user wildly missing the target at such lengthy distances.

The Applicant respectfully submits that Kilby does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Kilby does not disclose (expressly or inherently) all of the elements of Claims 1, 5 – 7, 9, 14 and 15.

Paragraph 5 of the Official Action

The Official Action rejected as-filed Claims 1-3, 5-7 and 19 under 35 U.S.C. §102(b) as being anticipated by Felts. The Applicant respectfully disagrees with this rejection particularly in view of the amendments made to the claims. The Applicant respectfully requests that Claims 1, 5 – 7 and 19 be favorably reconsidered and Claims 2 and 3 be cancelled.

The Examiner stated that item 15 of Felts allowed for vertical adjustment and are threadably connected to the base. The Applicant respectfully disagrees with this interpretation of item 15 in Felts. The Applicant respectfully asserts that item 15 in Felts is not defined or mentioned in any of the Specification (other than on the drawings). The Applicant will assume that it is a standard tripod with extendable legs as is indicated by the Figures. If this is true, the applicant submits that extendable tripods must be simultaneously raised or lowered as per the three telescoping legs. This is not a feature of the present invention, as the legs of the present invention are independently raisable and/or lowerable.

Additionally, telescoping legs generally are not connected threadably to anything. There are rarely, if any, threadably connected telescoping support member, due to the

fact that making them threaded would require a substantial amount more effort than just placing the securing pins as shown in Felts.

The Applicant further asserts that the pivot adjuster on the tripod found in Felts does not provide for minute lateral movements that are provided for in the present invention. These tiny movements are necessary for sighting in firearms at long distances where a small overcompensation may cause a user to miss a target by several feet. Felts requires that the entire apparatus must be swiveled to pivot about the tripod, whereas the present invention only requires that the user turn a knob thereby swiveling the support unit in minor distances, without having to move the entire firearm support as shown as item 10 in Felts.

As per Claim 6 of the present invention, the Applicant respectfully submits that the support members in Felts are not threadably connected to the base. Even if they are threadably connected, it does not appear that there are multiple support members that are connected to the base in a vertical manner. Rather, it is one support member that is connected to the base in a vertical manner, and three non-vertical members that are connected to that one vertically connected support member.

Additionally, Felts does not have the handles (numbered 30 in the present invention) attached to each support member. This produces the same problems in as noted in the previous paragraphs regarding miscalculation and overcompensation when sighting in a firearm. The handles of the present invention provide simple and efficient raising or lowering of any corner of the base unit. The (apparent) telescoping manner of the support members in Felts do not lend themselves well to small changes in positioning because easily swivelable nature of tripods.

Claims 14 and 15 state as follows:

14. (Currently Amended) The adjustable firearm support system of Claim 1, wherein said pivot adjuster includes a pivot pin extending upwardly that is received by a support slot within said support unit.

15. (Original) The adjustable firearm support system of Claim 14, wherein said pivot adjuster is comprised of a threaded shaft with a threaded collar threadably positioned upon said threaded shaft and wherein said pivot pin is attached to said threaded collar.

Claims 14 and 15 use language further distinguishing the pivot adjuster from the structure, function and teachings of Felts. These features include the support slot receiving the pivot pin and the threaded shaft with a threaded collar. The threaded shaft and collar was referred to in a previous paragraph because of the necessity of minute movements to reposition the firearm support. This is necessary because often a firearm is being sighted in at 300 to 400 yards and the slightest miscalculation when sighting in a firearm could result in a user wildly missing the target at such lengthy distances.

Finally, Claim 19 requires a Y-shaped base, whereas Felts seems to posit a V-shaped base. This would be significant because of the weight distribution since there are not support member extending from each of the "arms" of the Y in the present invention. Felts not only lacks the Y-shape, but all of the weight is positioned over the meeting point of the two arms at the base of the V-shape and the support members again do not extend from each corner to the underlying surface. This could cause instability in Felts where stability is not a question in the present invention.

The Applicant respectfully submits that Felts does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Felts does not disclose (expressly or inherently) all of the elements of Claims 1-3, 5-7 and 19.

Paragraph 6 of the Official Action

The Official Action rejected Claim 20 under 35 U.S.C. §103(a) as being unpatentable over Felts in view of any of Felts or Looney. The Applicant respectfully disagrees with this rejection of this claim.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

“To establish a prima facie case of obviousness, three basic criteria must be met.” MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined

teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

The Applicant would like to reiterate the dissimilarities between the present invention, Kilby and Felts advanced in the responses to Paragraphs 4 and 5 of the Official Action. Regarding the Looney reference, the Applicant respectfully submits that the T-shape in Looney positions the center of gravity at the intersection of the three legs. Therefore, Looney does not have the center of gravity in the center of the three legs and does not have the stability necessary to withstand a forward jolt without being more susceptible to tipping over than the present invention.

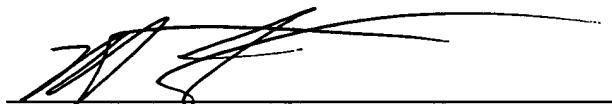
Additionally, the Felts Y-shaped reference has similar instabilities, but for different reasons. The Felts reference positions the gun in the middle of the Y-shaped center of gravity, but because of the lack of a leg extending from each corner of the Y-shape, the stability is reduced. Looney may solve this problem, but in practice presents new instability questions.

For these reasons, among others, the combination of Kilby with any of Felts or Looney cannot suggest the combination of features in applicant's Claim 20, and it is therefore submitted that the rejection against this claim should be withdrawn and Claim 20 allowed.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



Michael S. Neustel (Reg. No. 41,221)
NEUSTEL LAW OFFICES, Ltd.
2534 South University Drive, Suite No. 4
Fargo, North Dakota 58103

Date: October 13, 2004

Telephone: (701) 281-8822
Facsimile: (701) 237-0544
e-mail: Michael@neustel.com

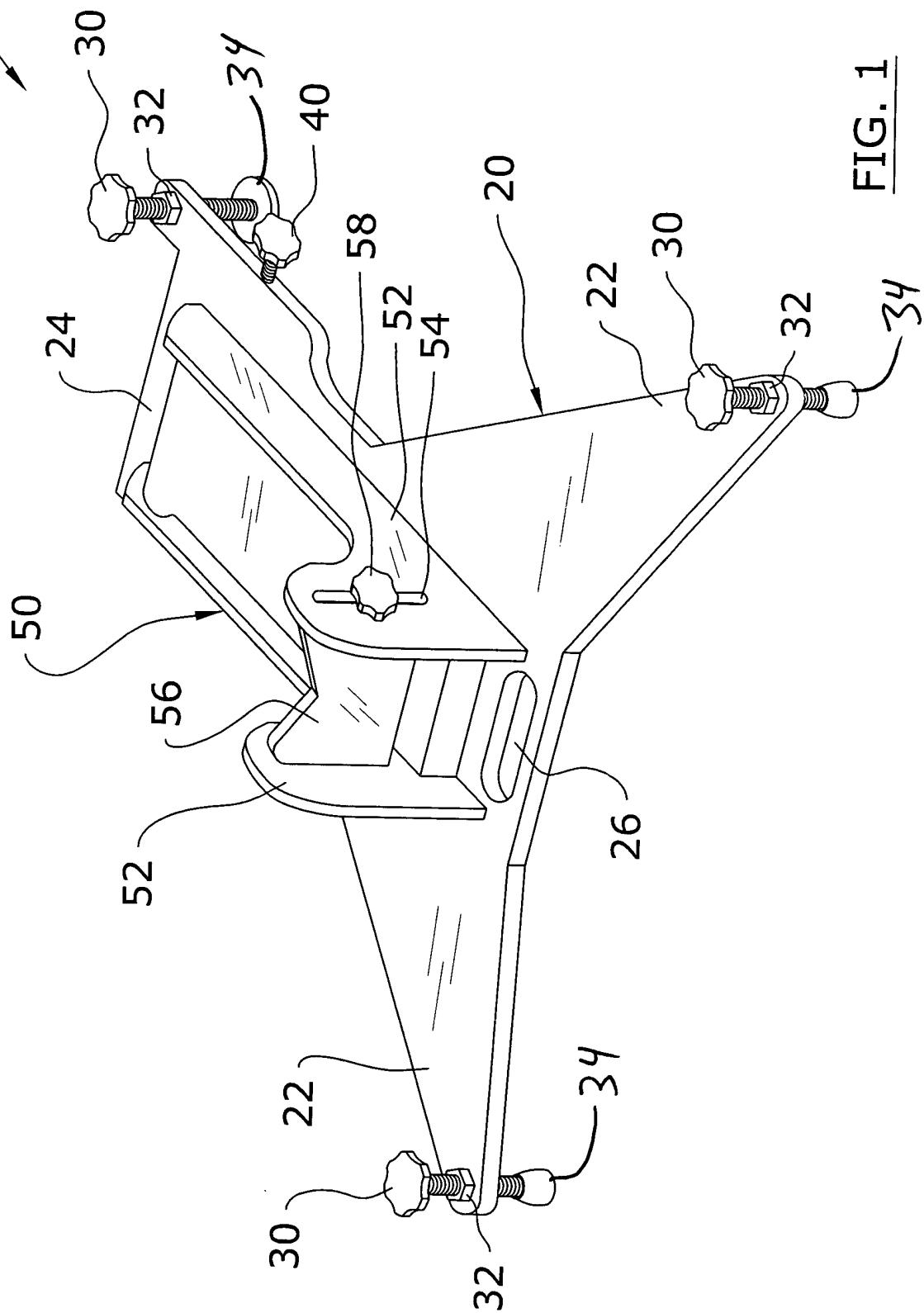


FIG. 1

Marked Up

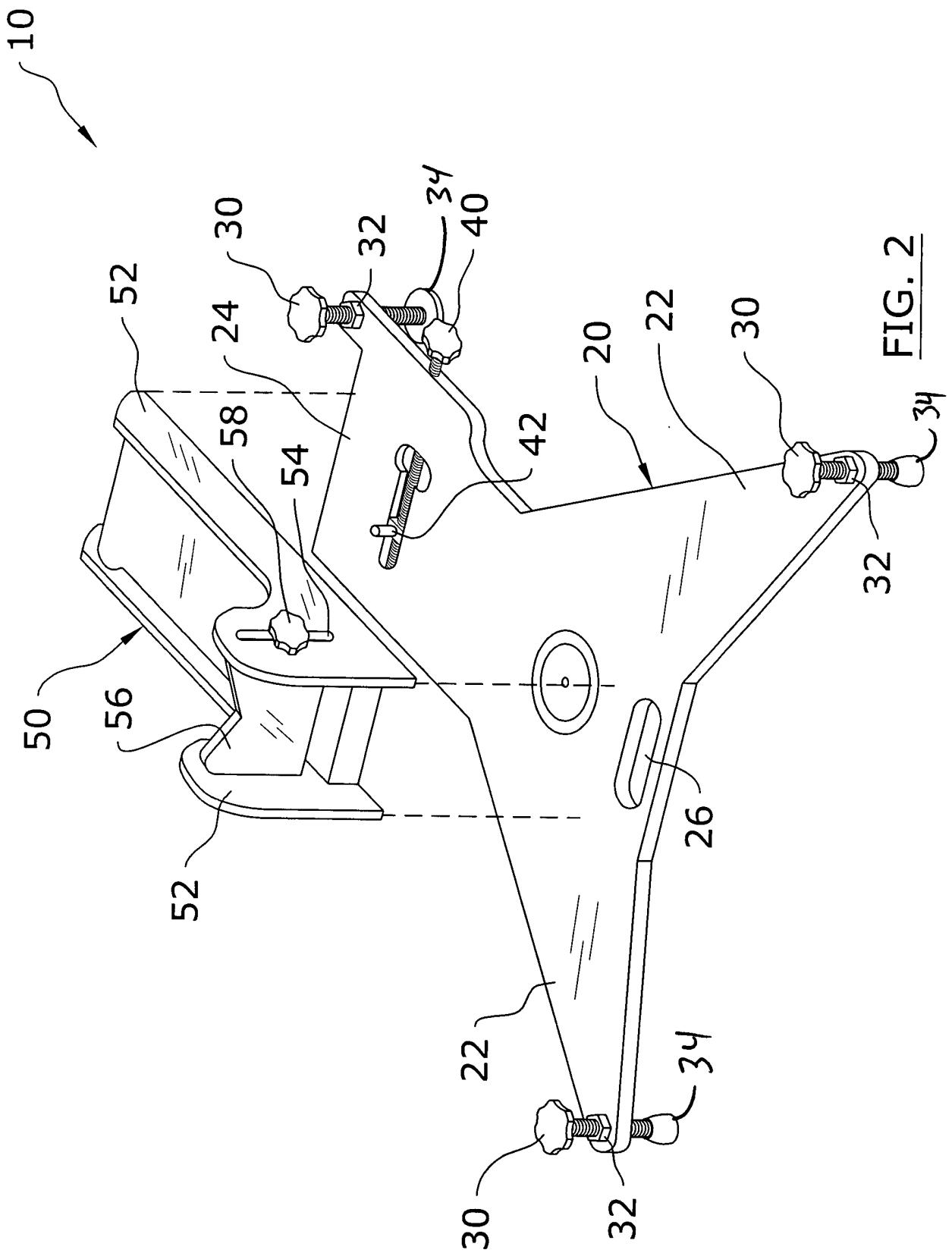


FIG. 3

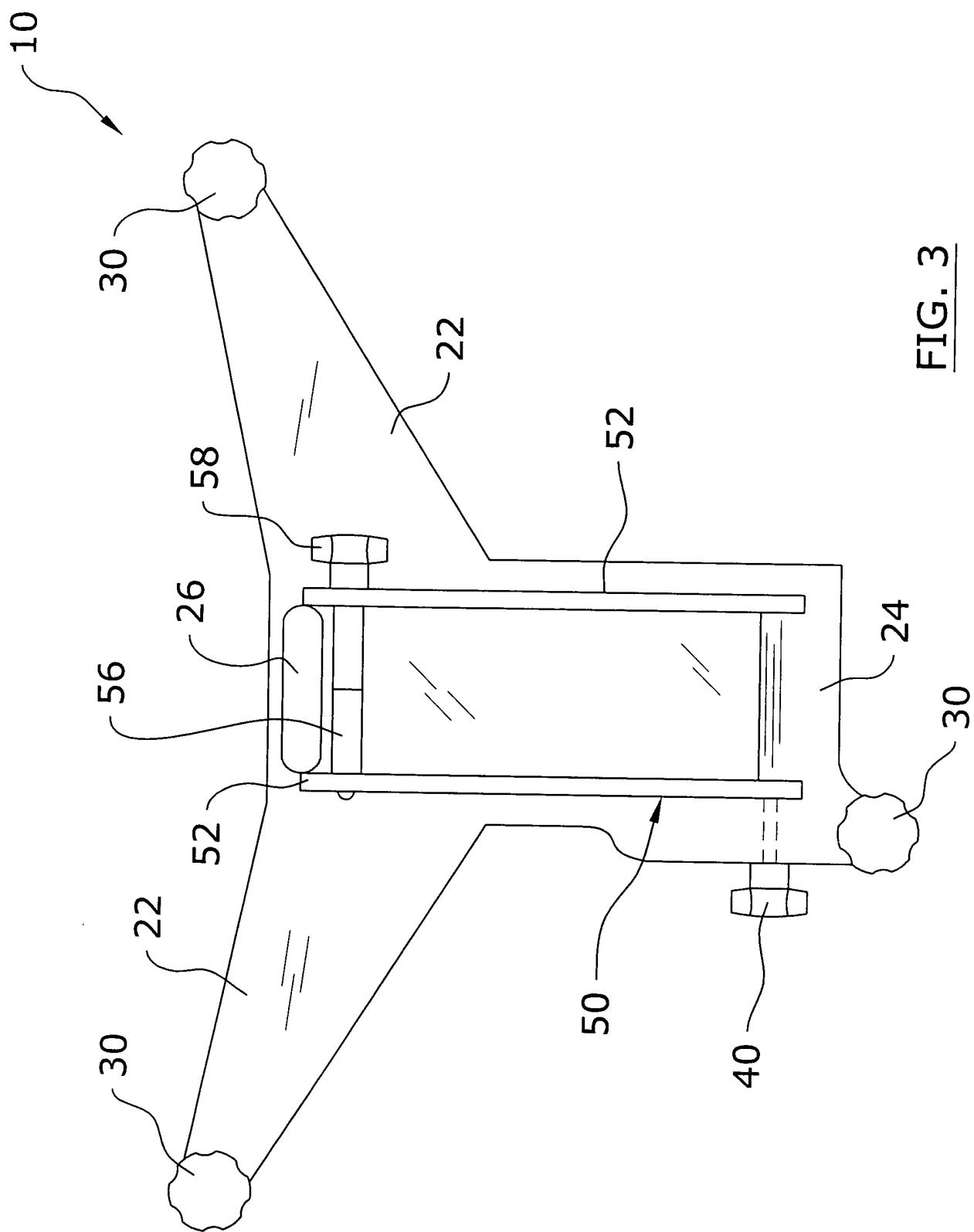


FIG. 4

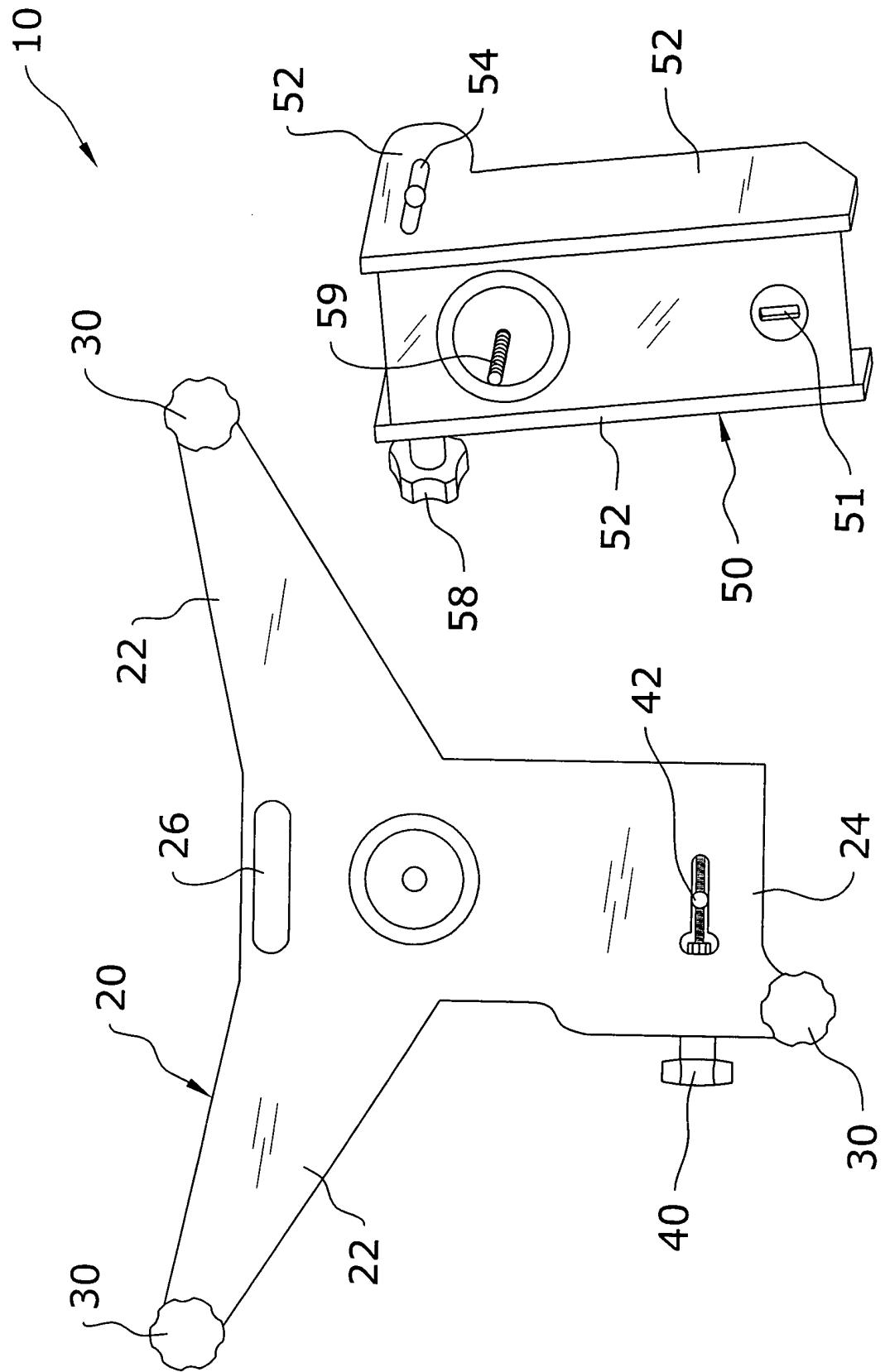


FIG. 5

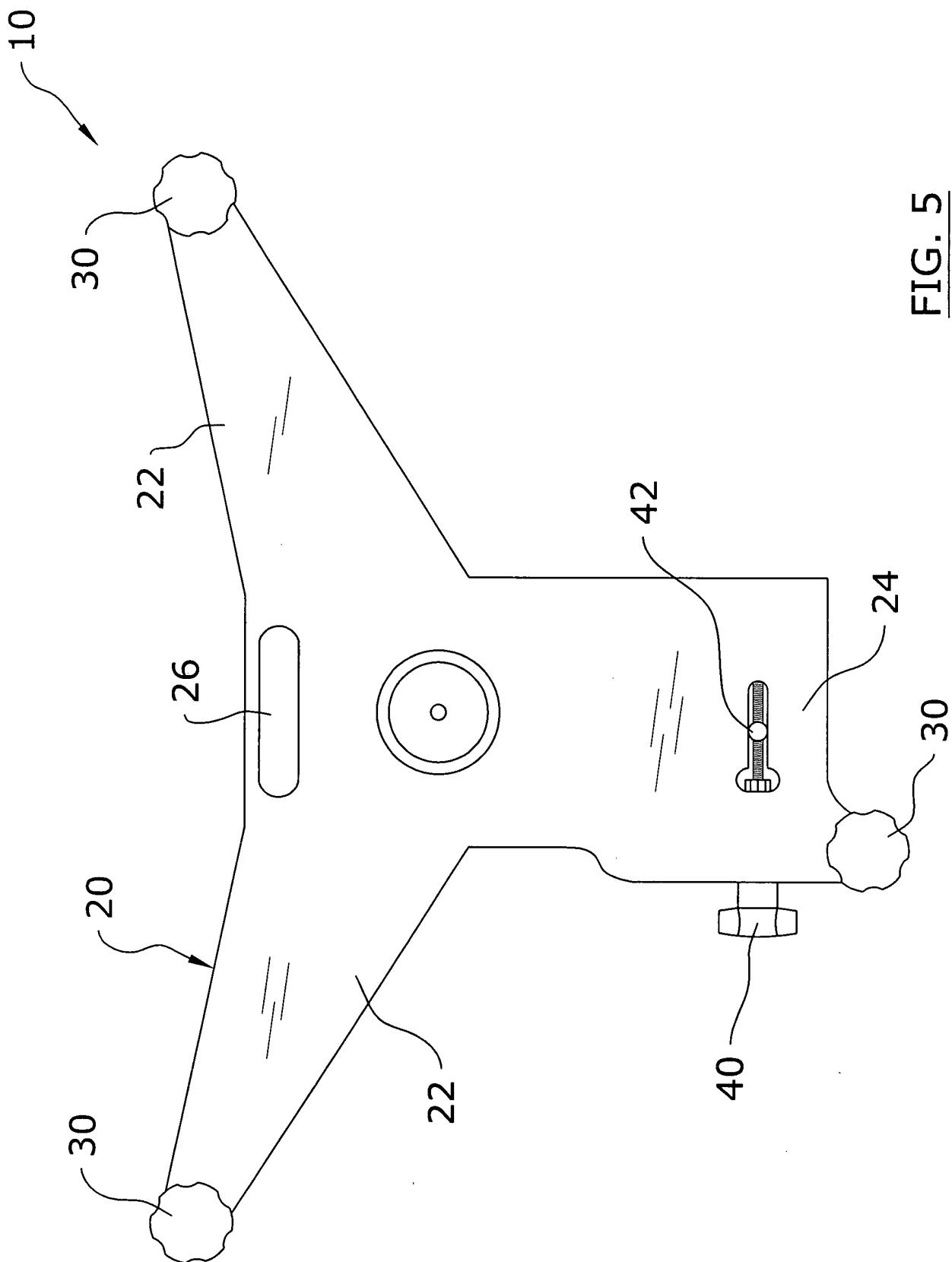
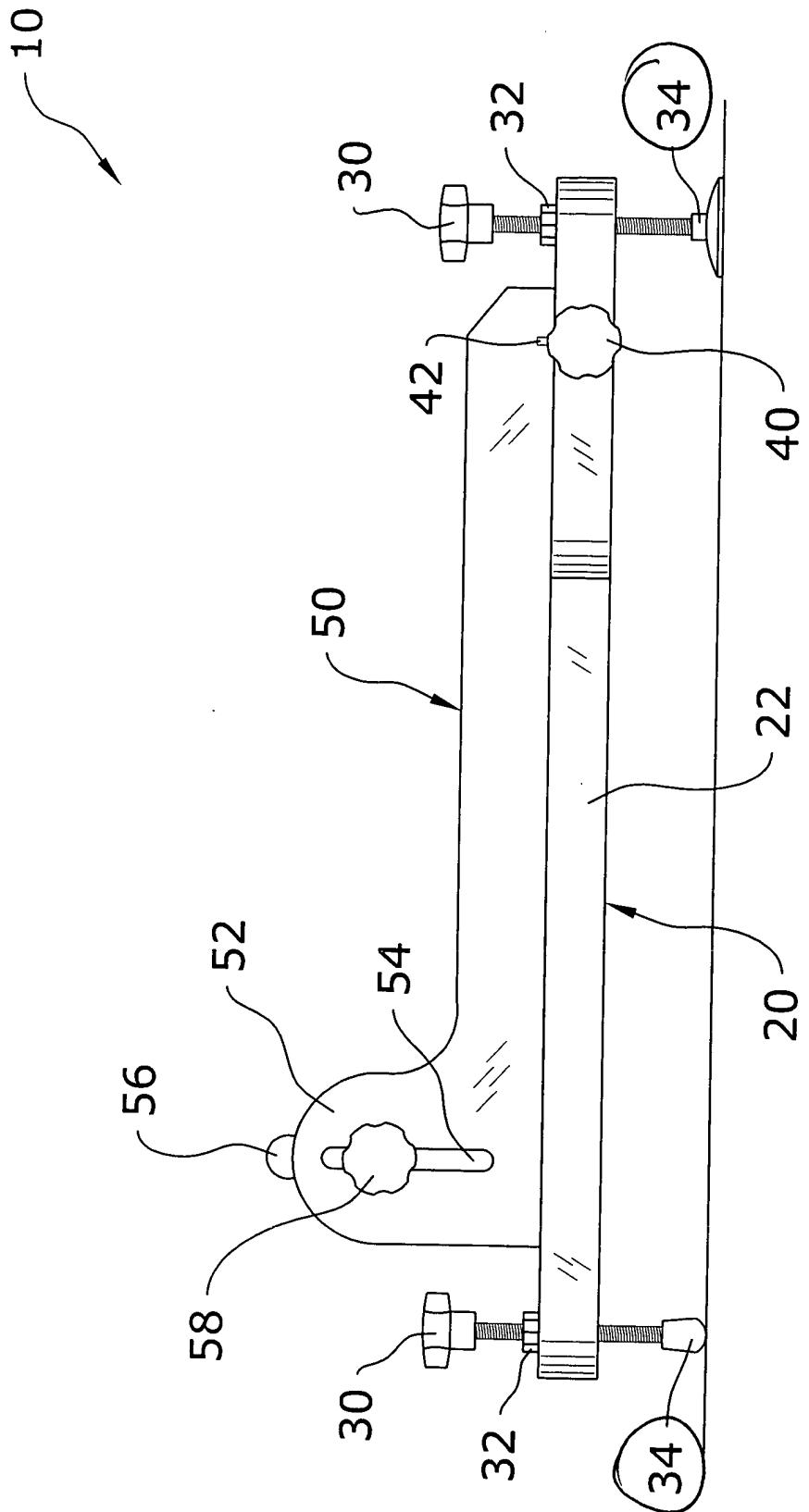


FIG. 6



Marked up

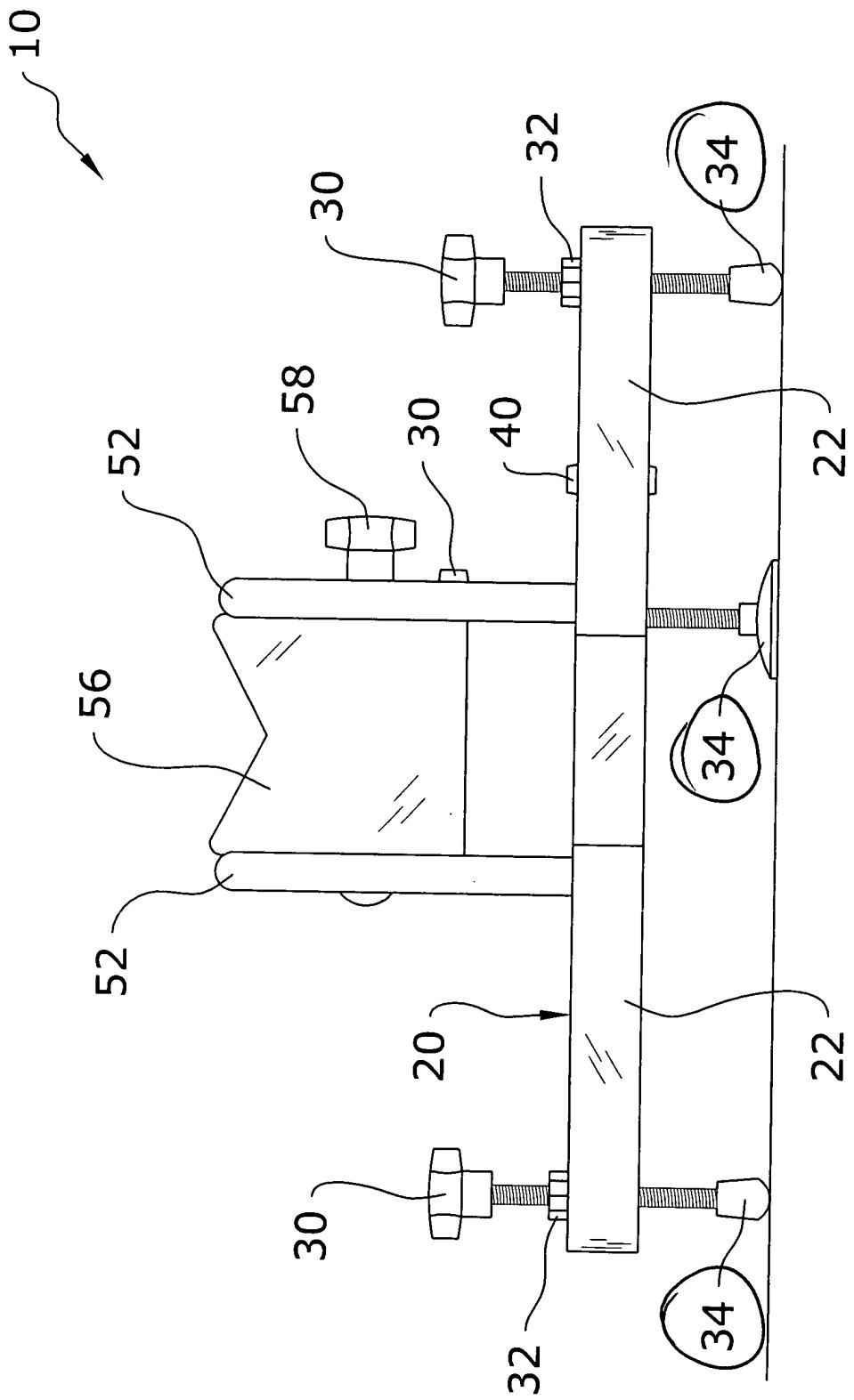


FIG. 7

Marked Up

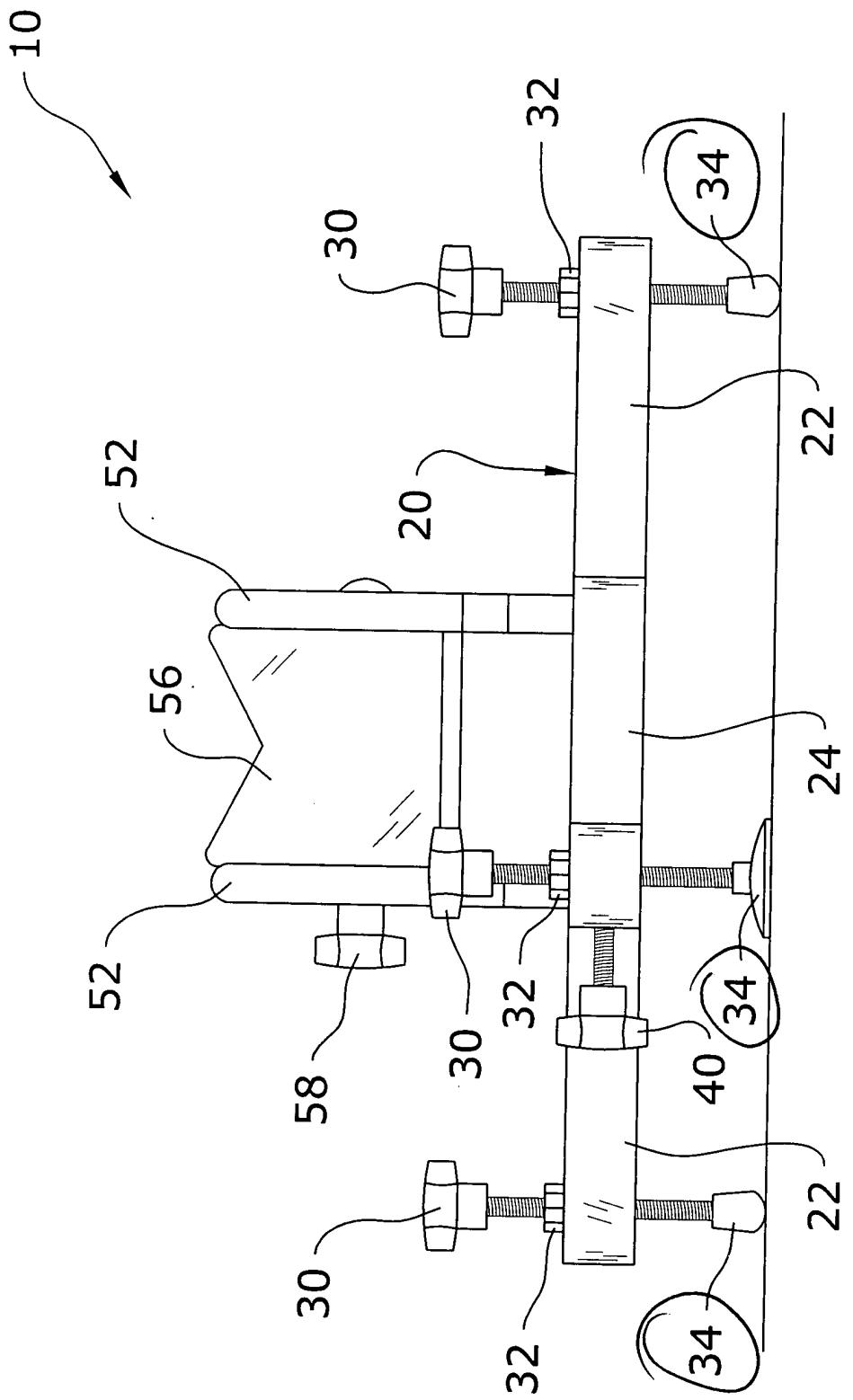
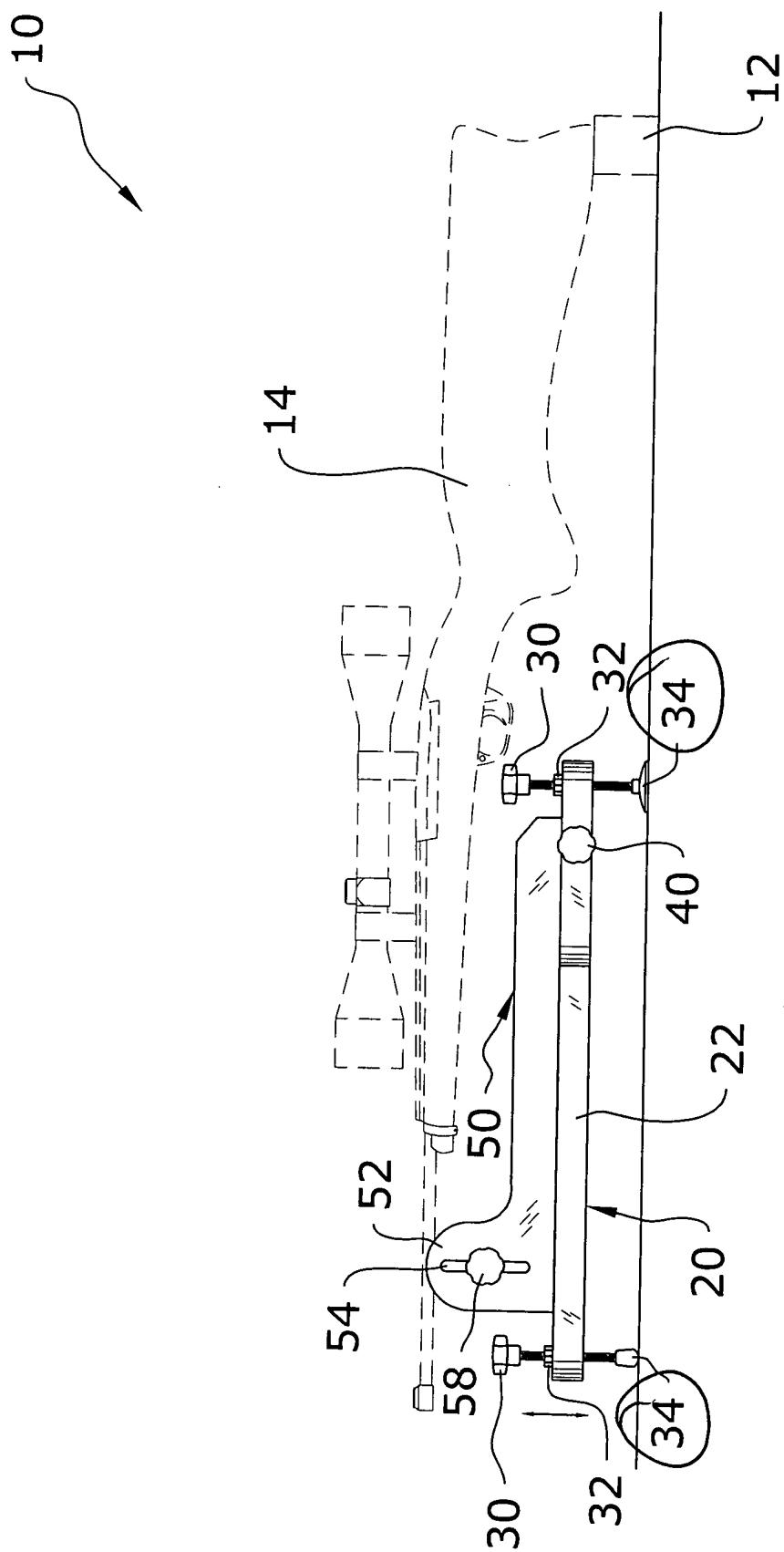


FIG. 8

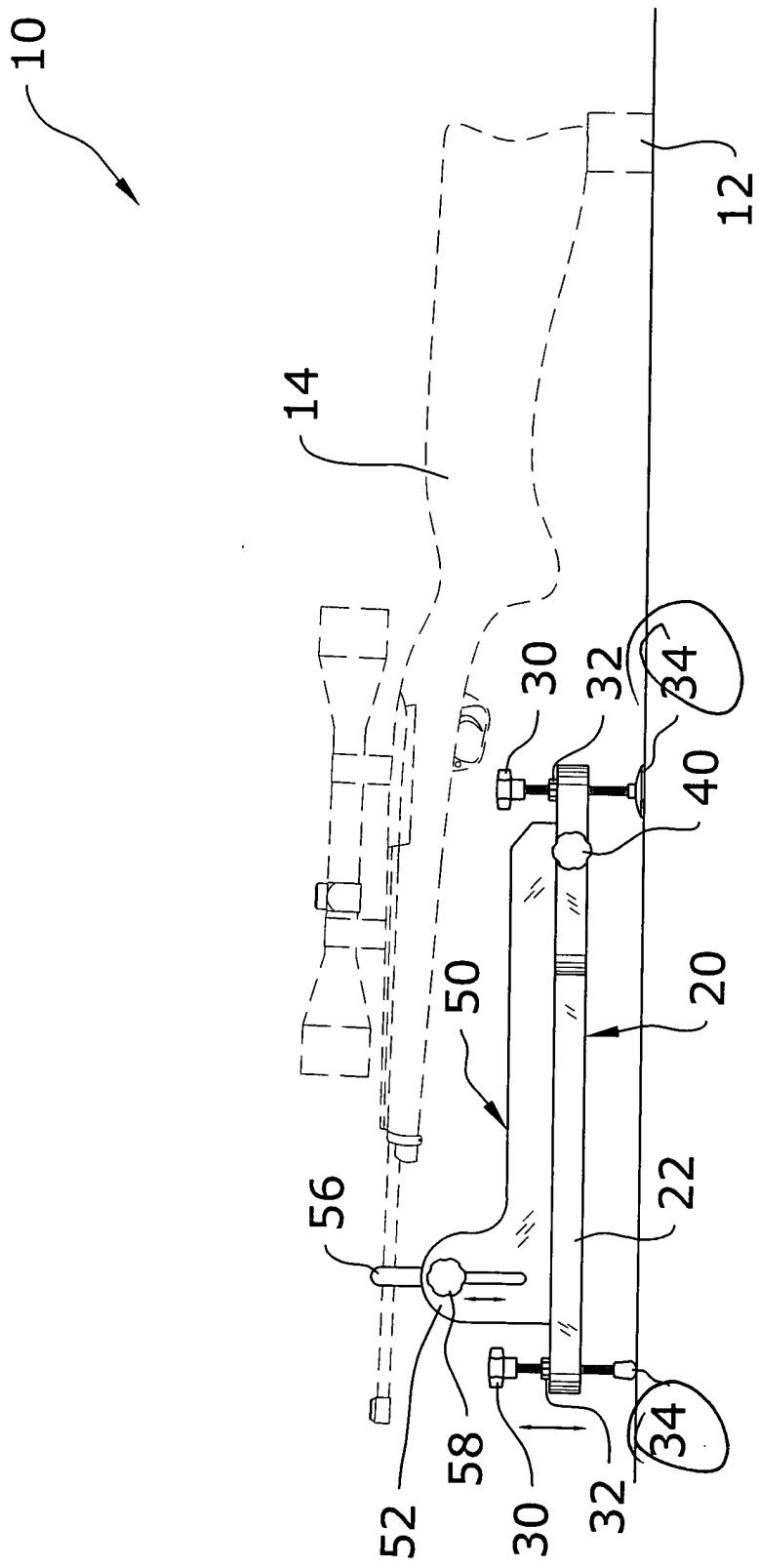
Marked Up

FIG. 9



Marked up.
,

FIG. 10



Marked Up